

REMARKS

Applicants would like to thank the Examiner for withdrawal of the previous rejections.

The rejection of claim 20 under 35 U.S.C. § 112, second paragraph,¹ is respectfully traversed. The term "a biologically active agent" in line 1 of the claim is a sufficient antecedent basis, since it begins with "a". Applicants respectfully request that this rejection be withdrawn.

The rejection of claims 21-23, 25-31, 33, 34, and 36 under 35 U.S.C. § 112, second paragraph, as being indefinite as to whether hyaluronic acid is part of a "biologically active agent" is respectfully traversed.

Claim element (a) specifies "hyaluronic acid dissolved in a physiological buffer." Claim element (b) specifies "particles, comprising (i) a biologically active agent, and (ii) a biocompatible polymeric matrix." The claim differentiates spatially a biologically active agent from hyaluronic acid. The biologically active agent is situated as part of the particles. The hyaluronic acid is outside the particles. Therefore, the hyaluronic acid is situated outside the particles, physically separated from the biologically active agent within the meaning of the active claims. Applicants submit that the metes and bounds of the claim is clear and definite. Applicants respectfully request that the rejection of these claims be withdrawn.

The rejection of claims 21-23, 26, 27, and 34 under 35 U.S.C. § 102(a) over Pierre *et al.* (Fr 2,778,847, November 1999) is respectfully traversed. Pierre *et al.* is not available as prior art.

On the DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY, the Applicants claimed the benefit under 35 U.S.C. § 119(e) of US Provisional Application No. 60/159,739, filed on October 15, 1999. Furthermore, Applicants filed a Preliminary Amendment wherein page 1, line 12 of the specification was amended to include this priority claim. Applicants have submitted a Request to Correct Filing Receipt to reflect the priority claim.

The Pierre *et al.* reference was published on November 26, 1999, after the filing date of the priority claim. Thus, the cited reference is not prior art under 35 U.S.C. § 102(a). Applicants request that the rejection of these claims be withdrawn.

The rejection of claims 17, 20, 21-23, 26-29, 34, and 35 under 35 U.S.C. § 103(a) over Pierre *et al.* (Fr 2,778,847, November 1999) taken with Mathiowitz *et al.* (U.S. Patent 5,985,354) is respectfully traversed. Pierre *et al.* is not available as prior art, and Mathiowitz *et al.* alone is insufficient to maintain the rejection.

As noted above, Pierre *et al.* is not available as prior art under 35 U.S.C. § 102. Since Mathiowitz *et al.* does not teach or suggest the entire subject matter of the active claims, this reference cannot serve as the sole basis for the rejection of these claims under 35 U.S.C. § 103. Applicants respectfully request that the rejection of these claims be withdrawn.

Claims 36 and 37 stand objected as being dependent upon a rejected base claim. In light of Applicants' remarks to the Examiner's rejection of the claims, Applicants request that the objections to claims 36 and 37 be withdrawn.

Applicants submit that the present application is in condition for allowance. Early notice of such action is earnestly solicited.

Respectfully submitted,

Daniel W. Celander
Daniel W. Celander, Ph.D.
Registration No. 52,710
Representative for Applicant

SONNENSCHEIN NATH & ROSENTHAL
P. O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606
(312) 876-8071